REMARKS

In the Office Action, claims 1, 3-11, 13-20, 22-35, 39, 40, 43-45 and 47-51 were rejected. Applicant traverses this rejection. No amendments have been made in response to the Office Action, and claims 1, 3-11, 13-20, 22-35, 39, 40, 43-45 and 47-51 remain pending in the present application.

In 35 USC 2, the powers and duties of the United States Patent and Trademark Office are set forth. Under those specific powers, the Patent Office "shall facilitate and expedite the processing of patent applications" as set forth in 35 USC 2(b)(2)(C). Applicant respectfully asserts the Patent Office has not acted in a manner that facilitates and expedites the processing of patent applications with respect to the present application. In an early Office Action, claims 1-11, 13-20 and 22-35 were allowed. That allowance was withdrawn in the subsequent Office Action, and claims 47-51 were allowed. The allowance of claims 47-51 was then affirmed in the next Office Action. However, the allowance of claims 47-51 has been withdrawn in the present Office Action, and those claims have been newly rejected under 35 USC 112 (independent claim 51) and under 35 USC 102.

No changes were made to the language of independent claim 51, but the new rejection under 35 USC 112 was provided after numerous previous Office Actions in which no such concerns were raised. Furthermore, the present Office Action rejects all pending claims based on 14 different rejections, many of which rely on the same references used in prior Office Actions. Within the 14 different rejections, support for various assertions made in the present Office Action was provided through Official Notice. Respectfully, the practice of repeatedly allowing claims and withdrawing the allowance via numerous Office Actions without substantial changes in the cited art is not believed in keeping with the mandate of the US Patent and Trademark Office.

In the Office Action, claims 39 and 51 were rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential elements, and MPEP 2172.01 was cited for support. This rejection is respectfully traversed. Both claims 39 and 51 clearly recite their

respective systems along with the elements of those systems while providing no gaps between elements. The language of these claims omits no essential elements and falls far short of the standard for "unclaimed essential matter" discussed in MPEP 2172.01. According to section 2172.01, it "is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result" as established in *Ex parte Nolden*, 149USPQ 378, 380 (Bd. Pat. App.1965). In contrast to this high bar for establishing "unclaimed essential matter," the subject claims 39 and 51 clearly recite their respective systems as fully supported in the specification. For example, claim 39 recites:

> "a motor section having an electrical cable connection, the electrical cable connection having a terminal block movable between a sealed position and an open position that enables fluid communication between a connection interface and an interior volume of the motor section further comprising a spring to spring bias the terminal block toward the sealed position and a dielectric gasket to limit electrical tracking";

and claim 51 recites:

> "an electric submersible pumping system having a motor section and a protector section, wherein at least one of the motor section and the protector section comprises a bubble sump to maintain any released gases in a dedicated volume, further comprising a relief valve system in communication with the dedicated volume to vent gas from the bubble sump".

Both of these claims provide clear recitations of their respective systems and the cooperating components of those systems. Accordingly, the rejection under 35 USC 112 should be withdrawn.

In the Office Action, claims 16-19, 22, 25-28 and 30-32 were rejected under 35 USC 102(b) as anticipated by the Shaw et al. reference, US Patent No.: 4,667,737. This rejection is respectfully traversed.

The Shaw et al. reference discloses a sealing apparatus that is used with a submersible motor. The sealing apparatus has a tubular housing assembly 10 attached to the top end of a conventional submersible electric motor housing 1. An end flange 1a on the conventional motor housing is mated with flange 10a of the tubular housing assembly 10. A motor shaft 1d is

provided with splines 1e that engage corresponding splines of a coupling 2. However, the Shaw et al. reference does not disclose axially affixing a motor section shaft with a motor protection section shaft, regardless of the contrary, unsupported assertions in the Office Action. Similarly, the Shaw et al. reference fails to disclose or suggest oil communication holes deployed at a nonzero angle with respect to a longitudinal axis such that the nonzero angle corresponds with an angle at which the motive unit is positioned relative to vertical during filling of the motive unit with oil, again contrary to unsupported assertions made in the Office Action.

By way of specific examples, the Shaw et al. reference fails to disclose or suggest "connecting a motor section shaft to a protector section shaft to form an axially affixed connection"; or prefilling the combined motor section and protector section "prior to delivery of the combined motor section and protector section to a wellbore location " as recited in independent claim 16. Additionally, the references fail to disclose or suggest "delivering the motive unit to an oil production well as a single unit" or "providing the motive unit with a plurality of oil communication holes deployed at a nonzero angle with respect to the longitudinal axis such that the nonzero angle of the plurality of oil communication holes corresponds with an angle at which the motive unit is positioned relative to vertical during filling of the motive unit with oil" as recited in independent claim 26. Accordingly, the Shaw et al. reference fails to disclose each and every element of the subject claims, and rejection under 35 USC 102(b) must be withdrawn.

Claims 17-19, 22, 25, 27-28 and 30-32 ultimately depend from one of the independent claims discussed above, and each claim recites additional elements. Accordingly, the rejection of these dependent claims under 35 USC 102(b) also should be withdrawn.

In the Office Action, claims 39 and 40 were rejected under 35 USC 102(b) as anticipated by the Shilman reference, RU 2162272 C1. This rejection is respectfully, but strongly traversed.

The Shilman reference describes a combined electric motor 1 having a head 2 with a cable entry. The cable entry has a plug 5 whose body 6 is fastened to the head 2 at a plug

receptacle 8. Within receptacle 8, a relief valve is constructed via a separate spring-loaded stem 16 or via a plug 17 placed in an opening 18. (See description and Figures 2, 3).

However, neither of these arrangements discloses or suggests using the "terminal block" as a movable member between "a sealed position and an open position" that enables fluid communication, as recited in independent claim 39. The movable terminal block is unique relative to the teachings of the cited document, because it greatly simplifies construction of the cable connection as opposed to using separate check valves and corresponding flow channels as described in the Shilman reference. The Shilman reference describes spring biased stem 16 within receptacle 8, but it simply fails to teach any type of terminal block that is movable between positions. As described in previous responses, the reference also fails to disclose other elements of the subject claims, and the rejection under 35 USC 102 (b) is unsupported. Accordingly, the rejection should be withdrawn.

Claim 40 directly depends from independent claim 39 and recites additional elements. Accordingly, the rejection of claim 40 also should be withdrawn.

In the Office Action, claims 47-51 were rejected under 35 USC 102(e) as anticipated by the Du et al. reference, US Publication No.: 2005/0087343. This rejection is respectfully traversed.

The Du et al. reference describes a system and method for reducing wear on a motor protector. In one embodiment, a motor protector 16 comprises a vent passageway 88 for venting air from a head section chamber 66 during oil-filling or other procedures. (See page 3, paragraph 0030). In the Office Action, page 5, a statement is made that the Du et al. reference discloses a protector section comprising "a bubble sump (88)" however this label is provided only in the Office Action. The actual reference does not describe a bubble sump but rather "a vent passageway 88" that can be used to vent air during filling of the motor protector with oil. Because the cited reference fails to disclose each and every element of independent claim 51, e.g. "a bubble sump to maintain any released gases in a dedicated volume", the rejection under 35 USC 102(e) must be withdrawn. It should be noted that because the cited reference fails to

disclose elements of the subject claims, it is not necessary to address any ineffectiveness of the reference based on the potential common inventorship or prior invention.

Claims 47-50 directly depend from independent claim 51 and recite additional elements. Accordingly, the rejection of dependent claims 47-50 also should be withdrawn.

In the Office Action, claims 1, 3-5, 7, 8, 15, 23 and 33 were rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference in view of the Scarsdale reference, US Patent No.: 6,290,430. This rejection is respectfully traversed.

As described above, the Shaw et al. reference discloses a sealing apparatus that is used with a submersible motor. The sealing apparatus has a tubular housing assembly 10 attached to the top end of a conventional submersible electric motor housing 1. A motor shaft 1d is provided with splines 1e that engage corresponding splines of a coupling 2, but the connection is not axially affixed. Furthermore, the Shaw et al. reference fails to disclose or suggest oil communication holes deployed at a nonzero angle with respect to a longitudinal axis such that the nonzero angle corresponds with an angle at which the motive unit is positioned relative to vertical during filling of the motive unit with oil.

Accordingly, the cited references, taken alone or in combination, fail to disclose, teach or suggest elements of the pending claims. For example, the references fail to disclose, teach or suggest a motive unit in which the motor section "comprises a motor section shaft and the motor protector section comprises a motor protection section shaft, the motor section shaft and the motor protector section shaft being axially affixed to each other with respect to a longitudinal axis of the motive unit" as recited in independent claim 1. By way of further example, the references also fail to disclose, teach or suggest connecting a motor section shaft to a protector section shaft "to form an axially affixed connection"; or refilling the combined motor section and protector section "prior to delivery of the combined motor section and protector section to a wellbore location " as recited in independent claim 16 and therefore in its dependent claim 23. Additionally, the references fail to disclose, teach or suggest "delivering the motive unit to an oil production well as a single unit" or "providing the motive unit with a plurality of oil

communication holes deployed at a nonzero angle with respect to the longitudinal axis such that the nonzero angle of the plurality of oil communication holes corresponds with an angle at which the motive unit is positioned relative to vertical during filling of the motive unit with oil" as recited in independent claim 26 and therefore in its independent claim 33. The Scarsdale reference is relied on as disclosing self-lubricating bushings. However, regardless of whether the Scarsdale reference discloses such features, the Shaw et al. reference completely fails to disclose the elements for which it is cited. Accordingly, no prima facie case of obviousness can be established, and the rejection under 35 USC 103 should be withdrawn.

Claims 3-5, 7, 8 and 15 ultimately depend from independent claim 1 discussed above, and each claim recites additional elements. Accordingly, no prima facie case of obviousness can be established with respect to these dependent claims, and the rejection should be withdrawn.

Furthermore, the rejection of the pending claims 3-5 was supported by the taking of Official Notice that these claims recite equivalent connections to the connection disclosed in the Shaw et al. reference. However, even the Shaw et al. reference fails to disclose the subject elements of independent claim 1, including a motor section shaft and a motor protector section shaft being "axially affixed" to each other. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicant hereby seasonably traverses and challenges the Examiner's use of Official Notice. Specifically, the Applicant respectfully requests that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action.

In the Office Action, claim 6 was rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference in view of the Scarsdale reference and further in view of the Shilman reference. This rejection is respectfully traversed; however claim 6 depends from independent claim 1. The Shilman reference provides no additional disclosure that would obviate the deficiencies of disclosure in the Shaw et al. and Scarsdale references as discussed above with respect to corresponding independent claim 1. Accordingly, no prima facie case of obviousness has been established, and the rejection should be withdrawn.

In the Office Action, claims 9-11 were rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference in view of the Scarsdale reference and further in view of the Kinsinger reference, US Patent No.: 6,091,175. This rejection is respectfully traversed; however claims 9-11 ultimately depend from independent claim 1 and recite additional elements. The Kinsinger reference provides no additional disclosure that would obviate the deficiencies of disclosure in the Shaw et al. and Scarsdale references as discussed above with respect to corresponding independent claim 1. Accordingly, no prima facie case of obviousness can be established with respect to these dependent claims, and the rejection should be withdrawn.

Furthermore, the rejection of the pending claim 11 was supported by the taking of Official Notice that it would have been obvious to use a tolerance ring connection. However, Applicant disagrees with this assertion. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicant hereby seasonably traverses and challenges the Examiner's use of Official Notice. Specifically, the Applicant respectfully requests that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action.

In the Office Action, claims 13 was rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference in view of the Scarsdale reference and further in view of the Vandevier reference, US Patent No.: 4,521,708. This rejection is respectfully traversed; however claim 13 depends from independent claim 1 and recites additional elements. The Vandevier reference provides no additional disclosure that would obviate the deficiencies of disclosure in the Shaw et al. and Scarsdale references as discussed above with respect to corresponding independent claim 1. Accordingly, no prima facie case of obviousness has been established, and the rejection should be withdrawn.

In the Office Action, claim 14 was rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference in view of the Scarsdale reference and further in view of the Howell et al. reference, US Patent No.: 6,602,059. This rejection is respectfully traversed; however claim 14 depends from independent claim 1 and recites additional elements. The Howell et al. reference provides no additional disclosure that would obviate the deficiencies of disclosure in

the Shaw et al. and Scarsdale references as discussed above with respect to corresponding independent claim 1. Accordingly, no prima facie case of obviousness has been established, and the rejection should be withdrawn.

In the Office Action, claim 20 was rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference in view of the Shilman reference. This rejection is respectfully traversed; however claim 20 depends from independent claim 16. The Shilman reference provides no additional disclosure that would obviate the deficiencies of disclosure in the Shaw et al. reference as discussed above with respect to the corresponding independent claim 16. Accordingly, no prima facie case of obviousness has been established, and the rejection should be withdrawn.

In the Office Action, claim 29 was rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference. This rejection is respectfully traversed; however claim 29 ultimately depends from independent claim 26 and recites additional elements, e.g. "a single, unitary shaft". The Shaw et al. reference provides no additional disclosure or suggestion relative to that discussed above with respect to independent claim 26. Accordingly, the Shaw et al. reference fails to establish a prima facie case of obviousness with respect to independent claim 26 or its dependent claim 29. The rejection under 35 USC 103(a) should be withdrawn.

In the Office Action, claim 34 was rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference in view of the Vandevier reference. This rejection is respectfully traversed; however claim 34 depends from independent claim 26 and recites additional elements. The Vandevier reference provides no additional disclosure that would obviate the deficiencies of disclosure in the Shaw et al. reference as discussed above with respect to the corresponding independent claim 26. Accordingly, no prima facie case of obviousness has been established, and the rejection should be withdrawn.

In the Office Action, claims 24 and 35 were rejected under 35 USC 103(a) as unpatentable over the Shaw et al. reference in view of the Howell et al. reference. This rejection is respectfully traversed, however claims 24 and 35 depend from independent claims 16 and 26,

respectfully, and recite additional elements. The Howell et al. reference provides no additional disclosure that would obviate the deficiencies of disclosure in the Shaw et al. reference as discussed above with respect to the corresponding independent claims. Accordingly, no prima facie case of obviousness has been established, and the rejection should be withdrawn.

In the Office Action, claims 43-45 were rejected under 35 USC 103(a) as unpatentable over the Kinsinger reference in view of the Yamamoto et al. reference, US Patent No.: 6,854,556, and the Kurokawa et al. reference, US Patent No.: 6,394,220. This rejection is respectfully traversed.

The Kinsinger reference describes a submersible pumping system comprising a motor containing self-centering rotor bearing assemblies. Rotor sections 28 are rotatively coupled to a shaft 26, and sleeves 48 also are rotatively coupled to the shaft 26. However, the sleeves 48 are "not axially locked to shaft 26" to thereby provide a certain amount of freedom of movement in an axial direction. The axial movement is used to accommodate, for example, relative thermal expansion and contraction. (See column 4, lines 48-67). Accordingly, even if the Yamamoto et al. and the Kurokawa et al. references could be construed as disclosing sleeves press fit onto a shaft, the Kingsinger reference teaches against such an application in a submersible pumping system. Instead, the Kingsinger reference teaches the use of sleeves 48 that have freedom to move in an axial direction. This teaching would lead someone of ordinary skill in the art away from the combination proposed by the Examiner in the Office Action. Accordingly, no prima facie case of obviousness can be established, and the rejection of claims 43-45 must be withdrawn.

Furthermore, the Yamamoto et al. reference, in fact, teaches a power steering device that includes a torque limiter 11' that includes torque setting member 51. The torque setting member 51 is fitted between an outer circumference of a third shaft section and an inner circumference of a driven bevel gear such that it is subjected to diametric deformation. (See column 11, lines 50-57). The Kurokawa et al. reference also discloses a power steering device having a metal sleeve 11 formed integrally with a worm wheel 10 and fixed to a third shaft by press-fitting, a key, or the like. (See column 3, lines 42-46). However, neither of these supporting references describes

or suggests the journal bearing or the replaceable sleeve of the journal bearing, wherein the replaceable sleeve is press fit onto the drive shaft with a tolerance ring. This lack of disclosure, teaching or suggestion further establishes that no prima facie case of obviousness is supported by the cited references, and the rejection of claims 43-45 must be withdrawn.

In view of the foregoing remarks, the pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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